

REMARKS

Claims 1-32 are pending. Claims 11-32 have been withdrawn. Accordingly, claims 1-10 are at issue.

Claim 10 has been amended as suggested in the Office Action to overcome the §112 rejection. Accordingly, withdrawal of the rejection is believed appropriate.

The rejection of claims 1-10 as unpatentable over Koenig, Jr. et al (2002/0134035) in view of Anstadt et al (4,141,944) or Applicant's Admission is respectfully traversed. The rejection is based upon an improper modification of Koenig, Jr. et al and a failure to state a *prima facie* case of obviousness.

More specifically, in support of the modification of Koenig, Jr. et al by either Anstadt et al or Applicant's Admission, the Office Action asserts that the modification would be made "in order for the open cells of the expansive surfaces to better absorb and adhere drywall compound that is to be applied onto the expansive surfaces". However, this motivation/teaching is nonexistent in Anstadt et al or in Applicant's Admission. Rather, the desirability of using the open cells of the expansion surfaces "**to better absorb and adhere drywall compound**" is from Applicants' own specification. It is improper to rely on Applicants' specification in this manner in making a §103 rejection, and reveals the complete hindsight nature in reconstructing the claimed invention relying on Applicants' own disclosure for the rationale in support of the proposed modification. There is absolutely nothing in Anstadt et al or Applicant's Admission to indicate any advantage or desirability for making the proposed modification to Koenig, Jr. et al. Nor is there anything in Anstadt et al or Applicant's Admission to indicate that the proposed

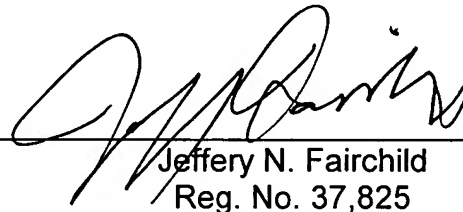
modification would be an improvement to Koenig, Jr. et al. Indeed, rather than an advantage, Anstadt et al and Applicant's Admission¹, both require additional steps, which would increase the cost and manufacturing time of the structure disclosed in Koenig, Jr. et al, without providing any disclosed or suggested benefit to the structure of Koenig, Jr. et al. Accordingly, the rejection is improper, fails to state a *prima facie* case of obviousness, and should be withdrawn.

In view of the foregoing, Applicant respectfully requests reconsideration of the rejections of claims 1-10 and allowance of the case.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER

By



Jeffery N. Fairchild
Reg. No. 37,825

October 7, 2008

500 West Madison Street
Suite 3800
Chicago, IL 60661
(312) 876-1800

¹(as alleged in the Office Action)